

1721



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Meng Hsin Chen et al.		
Serial No.:	10/511636	Case No.:	21101YP
Filed:	October 18, 2004		
For:	Ophthalmic Compositions for Treating Ocular Hypertension		

Art Unit
1612

Auth. Off.:
B. Packard

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is filed in response to the restriction requirement mailed May 22, 2008 and for which a response is due on June 22, 2008. Claims 1-25 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121:

Group I: claims 1-11, drawn to a compound of formula I.

Group II: claims 12-21 drawn to a method of treating an eye disease.

Applicants elect Group I, claims 1-11, drawn to a compound with traverse.

35 U.S.C. 121 specifies that if two or more independent and/or distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. See MPEP 802.01. Independent generally means that there is no disclosed relationship between the two or more claimed inventions. "Distinct" means that the inventions, although related, are capable of separate use and patentably distinguishable.

The Examiner based the restriction on the ground that the compounds lack a single inventive concept. However, a search of the compounds in Group II would require no additional burden on the part of the Examiner to conduct the prior art search for

Case 21101YP

examination of the present application in total since the use is directly tied to the compounds.

As required by the Examiner, applicants further elect the compound of example 26 as the species and assert that claims 1-11 are identified as encompassing the elected invention.

In view of the above, the Examiner is respectfully requested to withdraw the restriction requirement.

Authorization is hereby given to charge any fees which may be due as a result of this petition to Deposit Account No. 13-2755.

Respectfully submitted,

By: 

Sylvia A. Ayler

Reg. No. 36,436

Attorney for Applicant(s)

MERCK & CO., INC.

P.O. Box 2000

Rahway, New Jersey 07065-0907

(732) 594-4909

Date: June 11, 2008